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In re Application of :
Lars Abrahmsen et al :
Serial No.: 08/765,695 : PETITION DECISION
Filed: July 25, 1997 :
Attorney Docket No.: P01525US0 :

This is in response to applicants' petition under 37 CFR 1.144, filed April 4, 2000, which is a supplemental petition to a petition filed November 15, 1999, requesting withdrawal of an improper Lack of Unity requirement. The delay in acting on this petition is regretted.

A review of the file history shows that this application was filed under 35 U.S.C. 371 as the national Phase entry of PCT/SE95/00681 accepted on July 25, 1997. The examiner upon reviewing the application set forth a restriction requirement under 35 U.S.C. 121 and 372 in an Office action mailed October 16, 1998, as follows (claims 1-13 were canceled by preliminary amendment):

Group I - claims 14-35 drawn to a conjugate;
Group II - claims 36-51 drawn to an in vivo method of using the conjugate.

In reply to the restriction requirement applicants elected Group II, with traverse, arguing that the special technical feature identified by the examiner, the conjugate, is patentable over the prior art, contrary to the examiner's assertion. In the next Office action, mailed August 16, 1999, the examiner cited the explanation of Rule 13 of the PCT by referring to Annex B and quoting part (c), the first three paragraphs relating to claims in a combination/subcombination relationship, as here. The examiner maintained the requirement and made it Final. Applicants replied to the Office action on November 18, 1999, by filing a petition with respect to the restriction requirement and an amendment in which claims 14-35 were "provisionally" canceled pending decision on the petition. On February 11, 2000, the examiner issued a letter of non-responsiveness with regard to specific amendments and provided clarifying remarks with respect to the restriction requirement, inviting applicants to submit a modified or substitute petition. Applicants replied on April 4, 2000, with a corrected reply and this substitute petition. Subsequent to the petition being filed the examiner issued a new Office action requiring an election of species between species in Group II added by the last amendment.

DISCUSSION

The application, as filed and amended by the preliminary amendment, clearly contains claims directed to different, but related, inventions, a conjugate and a method of using the conjugate.

The inventions are in a combination/subcombination relationship. Based on the examination report issued by the Swedish Patent Office in the international phase, both the conjugate and method of using the conjugate lack novelty and inventive step with respect to specific prior art citations. Although this examination was done on claims 1-13 of the international application, newly submitted claims 14-51 correspond to claims 1-13. Insofar as the independent claims are concerned there is almost a word-for-word correspondence. (This is relatively easy to ascertain as the international application was filed in the English language.) Upon acting initially on the application the examiner made a determination of lack of unity based on the art of record (the examiner specifically referred to Buelow et al, cited on the ISA and discussed in the IPER) that the claims to the conjugate did not have unity with the claims of the method using the conjugate. In applicants' traversal of the restriction requirement after electing Group II, applicants acknowledged that the special technical feature linking Groups I and II is the conjugate, but disagreed that the requirement should be based on the conjugate not being patentable over the prior art of record. In rebuttal of applicants' remarks, the examiner quoted, with emphasis added, Annex B, part (c) which concludes by stating that where an independent claim does not avoid the prior art then the question of whether there is still an inventive link between the claims needs to be reconsidered and that where no link remains an objection to lack of unity may be raised. Further stated is the qualifier that in a combination/subcombination relationship between claims no question of lack of unity can be raised if the subcombination avoids the prior art, but that the converse is not true. The examiner then reiterated that the conjugate of Group I, although not elected for examination, does not avoid the prior art reference of Buelow et al. Applicants replied by "provisionally canceling" the claims of Group I and filing the first petition. The amendment was entered and claims 14-35 were canceled. Applicants should recognize that there is no "provisional" entry of an amendment based on subsequent prosecution other than a direction to an examiner giving permission to cancel non-elected claims by examiner's amendment when all claims being prosecuted are found allowable. That type of direction was not given here and the claims have been canceled. By canceling the claims applicants have, in effect, removed the basis for the restriction requirement. However, the petition is being decided as if the claims have not been canceled.

Applicants argue in the petition that the examiner based the original requirement on a misinterpretation of the Buelow et al reference and that the interpretation was changed in the letter of February 11, 2000. Applicants further argue that the teachings of Buelow et al do not anticipate the claims of Group I. Specifically, attention is focused on the claimed "modified ability to bind MHC class II antigens" caused by mutation of the conjugate. As noted from the directions given in Annex B, lack of unity is determined based only on the independent claims and if the independent claim does not avoid the prior art, then lack of unity exists. Both the Swedish Patent Office and the examiner in charge of this application found on examination that claim 14, or its earlier equivalents (claim 1), does not avoid the prior art. It is noteworthy that the Swedish Patent Office and the examiner both cited the same reference in showing the conjugate does not avoid the prior art. Although applicants appear to argue that the reference does not anticipate the prior art, Annex B does not require anticipation, merely that the claimed invention not avoid the prior art. This could be because of lack of novelty or lack of inventive step. The examiner's determination of lack of unity is not seen to be in error as the conjugate as set forth in claim 14 does not avoid the prior art.

DECISION

Applicants' petition is **DENIED** for the reasons set forth above.

Applicants are reminded that timely reply to the Office action mailed July 3, 2000, remains due, unless already filed. Upon receipt of the reply the application will be forwarded to the examiner for further consideration.

Any request for reconsideration of this decision or a renewed petition must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely and must be directed to the Assistant Commissioner of Patents. No extension of time will be permitted.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-5408.



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